

### III. REMARKS

Claims 1-20 are pending in this application. By this amendment, claims 1, 2, 7, 10, 11, 14, and 18 have been amended.

In the Decision on Appeal dated February 22, 2012, the Appeal Board affirmed the Office's rejections as set forth in the Final Office Action dated July 21, 2008. In that Final Office Action, claims 1 – 6 and 9-20 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Nishimura (U.S. Pub. No. 2001/0051904A1), hereafter "Nishimura," in view of Christensen et. al. (U.S. Pub. No. 2002/0154114A1), hereinafter "Christensen" and further in view of Breen Jr., et al. (U.S. Pat. No. 6,598,027), hereinafter "Breen." Claims 7-8 and 11-13 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Nishimura and Christensen, and further in view of Breen and further in view of Leber et. al. (U.S. Pub. No. 2003/0182391 A1), hereafter "Leber."

In response to the Board's comments in the Decision on Appeal that Appellants arguments were not commensurate with the scope of the claim language, Applicants have amended the claims to specify that the custom form is displayed *only when* the corresponding matching value matches the at least one value of each attribute for the item. *See*, Decision on Appeal, p. 4. In addition, Applicants have amended the claims to explicitly recite determining whether a user must provide required information as part of the purchase. *See*, Decision on Appeal, p. 5.

With regard to the 35 U.S.C. 103(a) rejections of independent claims 1, 10, 14 and 18, over Nishimura, Christensen and Breen, Applicants assert that the combination of these references does not teach each and every feature of the claimed invention.

For example, the cited references do not teach that a custom form is displayed only when a corresponding matching value of an attribute in the set of keys matches a value of an attribute for the item, as required by claims 1, 10, 14, and 18. The Office cites to Nishimura for disclosure of this element, specifically paragraph [0102], lns. 1-7 and paragraph [0103], lns. 7-9. However, Applicants submit that the cited portions of Nishimura do not teach the claimed elements. Interpreting Nishimura for purposes of this Amendment only, Applicants submit that Nishimura discloses a method for a user to customize a product for purchase. It allows a customer to choose the specifications of a product, such as a computer, and then the custom-made product is displayed so the customer can confirm the product has been customized as desired. Nishimura does not display a custom form only when a match has been made of attribute values. In other words, Nishimura does not determine whether a value of an attribute in a set of keys matches a value of an attribute for the item. In contrast, in Nishimura, when a user chooses a product that can be customized, a user is presented with options for choosing specifications to customize. This is not equivalent to the claimed system which determines whether a user must provide required government regulatory information as part of the purchase, and provides a custom form to the user for the user to input that information.

In addition to the fact that the cited references do not teach the same method for determining whether a custom form as discussed above is required and then providing that custom form to a customer, the cited references further do not disclose that this custom form obtains government regulatory information from the customer. The Office cites to Breen for disclosure of this element. However, interpreting Breen for purposes of this Amendment only, Applicants submit that Breen discloses that a user provides information confirming that they

have the necessary licenses in connection with a purchase. (*See e.g.*, cited portion of Breen col. 14, lns. 30-40). Breen does not disclose obtaining government regulatory information via a custom data form, as required by the claimed invention.

With respect to dependent claims, Applicants herein incorporate the arguments presented above with respect to the corresponding independent claims from which the claims depend. Furthermore, Applicants submit that all dependant claims are allowable based on their own distinct features. Since the cited art does not teach each and every feature of the claimed invention, Applicants respectfully request withdrawal of all the rejections.

#### **IV. CONCLUSION**

In addition to the above arguments, Applicants submit that each of the pending claims is patentable for one or more additional unique feature. To this extent, Applicants do not acquiesce to the Office's interpretation of the claimed subject matter or the references used in rejecting the claimed subject matter. Additionally, Applicants do not acquiesce to the Office's combinations and modifications of the various references or the motives cited for such combinations and modifications. These features and the appropriateness of the Office's combinations and modifications have not been separately addressed herein for brevity. However, Applicants reserve the right to present such arguments in a later response should one be necessary.

In light of the above, Applicants respectfully submit that all claims are in condition for allowance. Should the Examiner require anything further to place the application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the number listed below.

Respectfully submitted,

/Meghan Q. Toner/

Meghan Q. Toner, Reg. No. 52,142  
Hoffman Warnick LLC  
75 State Street, 14th Floor  
Albany, NY 12207  
(518) 449-0044 - Telephone  
(518) 449-0047 - Facsimile

Dated: April 20, 2012